

REMARKS

Reconsideration of the present application in view of the following remarks is requested respectfully. Claims 1 to 33 are pending. Claims 1 to 23 are rejected under 35 U.S.C. §112 ¶ 1. No claims or new matter have been added. Claims 24 to 33 are herein canceled.

Rejection under 35 U.S.C. §112 ¶ 1.

In the present Office Action, the only rejection to claims 1-23 is due to the examiner's rejection under 35 U.S.C. §112 ¶ 1 of applicants use of the terms "oxidatively labile hydroxyl protecting group and acid labile hydroxyl protecting group." The examiner states that the term renders the claims non-enabled. As the examiner's position is completely clear -- and completely erroneous -- applicants respectfully refuse to amend the claims in any way. Applicants respectfully traverse this rejection, and submit that the processes defined in the present claims would be fully enabled to one of ordinary skill in the art, once placed in possession of the present application.

Applicants further assert that the test of enablement, as defined in MPEP § 2164.01 is rather whether "one reasonably skilled in the art could make or use the invention from the disclosures in the patent **coupled with information known in the art** without undue experimentation. A panoply of protecting groups are known; the chemical armamentarium is well - stocked with them -- and any ordinary chemist is entirely facile with their employment. Persons of skill in the art understand them and they are clear. The examiner is requested to confer with her supervisor to confirm the veracity of the foregoing.

Undersigned has already provided to the examiner by facsimile abundant examples of the recognition in the art of the terms. Applicants point out that the protection of hydroxyl groups with reagents capable of being removed under acid and/or oxidative conditions is well known to a reasonably skilled artisan in a general treatise cited and specifically incorporated

in the present application (Greene and Wuts, "*Protective Groups in Organic Synthesis*", 3rd edition, pp. 17-245 (John Wiley & Sons, New York, **1999**). A second particularly useful treatise in this regard and brought again to the Examiner's attention is Philip J. Kocienski, "*Protecting Groups*", 2nd Edition, pages 4-9 and 20-94.¹ Both treatises were available to the reasonably skilled artisan at the time the application was filed, facsimile copies of both were previously provided to the Examiner, and both are now provided anew for the Examiner's convenience and for the record. Each provides discussion of various hydroxyl protecting groups as well as journal citations to provide additional experimental details. Applicants respectfully assert that the teachings of the present application and the disclosures of the treatises herein noted are **more than sufficient** to enable one reasonably skilled in the art to **make and use the full scope** of the claimed invention **without undue experimentation**.

In view of the foregoing discussion, reconsideration and withdrawal of the rejection under Section 112 ¶ 1 are requested respectfully.

If the examiner maintains her espoused view, then she is specifically requested to execute an affidavit setting forth the facts upon which she apparently relies in maintaining the rejection. The examiner should **never** make the determination based on personal opinion. The determination should always be based on the weight of all the evidence. See MPEP 2164.05.

Miscellaneous

Applicants are herein canceling Claims 24 to 33, without prejudice or disclaimer, solely for the purpose of expediting prosecution. Applicants hereby affirm the right to file one or more divisional applications directed to any of the non-elected subject matter.

¹ Applicants specifically direct the Examiner's attention to the type of language used in this treatise, such as for example, "protecting groups cleaved by acid" (i.e., acid-labile protecting groups) on page 5 and "protecting groups cleaved by oxidation" (i.e., oxidatively-labile protecting groups) on page 8, clearly indicating that protecting groups of this nature are understood and employed by one of reasonable skill in the art.

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PATENT

CONCLUSION

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable Action are requested respectfully.

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/Walter C. Frank/
Walter C. Frank
Registration No. 52,911

Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891
215.564.8986
Fax 215.568.3439